

REMARKS

I. Current Status of Claims

Prior to this Amendment, claims 74-159 were pending in this application, with the Examiner withdrawing from consideration claims 103-104, 124-126, 137-142 and 156, as evidenced by the Office Action summary. Claims 78 and 108 have been cancelled in this amendment. Claims 144, 154 and 155 are being amended herein to correct minor informalities. Claim 80 has also been amended herein. Claims 74-77, 79-107, and 109-159 therefore remain pending.

Although the Examiner has not explicitly stated, applicants appreciate that claims 74-77, 79, 81, 99, 101, 107, 129-132 and 154-155 have been allowed (as well as 92-95 and 98, insofar as they depend from claim 79), since they are neither withdrawn nor subject to any objection or rejection, and they are not dependent from a claim subject to any objection or rejection. Likewise, claims 88, 90 and 133, which the Examiner has identified as claims linking Species I and Species II, have also been allowed, since they are also not subject either to objection or rejection.

In response to the Office Action Mailed June 8, 2004, reconsideration is requested in light of the following remarks.

II. Substance of Interview

The Examiner is thanked for the courtesy of extending applicants' attorneys an interview on October 6, 2004. At the interview, applicants' attorneys explained that the restriction-election requirements are inappropriate in the present situation because they complicate the proposed interference proceedings. Furthermore, applicants' attorneys explained that the claims which the PTO sought to separate out from the subject

application were present in the same issued patents which applicants are seeking to involve in the interference. Applicants' attorneys said that they would follow with a formal response presenting these points (which is this paper).

The Examiner in turn indicated that he would carefully consider applicants' written response toward the possibility of reconsidering the restriction/election requirements. Following that, the advisability was discussed of a follow-up interview involving both the Examiner and the Special Programs Examiner (SPrE), to facilitate framing the interference.

III. General Comments

It is noted with appreciation that the Examiner recognizes that the claims of the subject application are of substantially the same scope as the claims of U.S. Patent No. 6,326,280 ("280 patent") and U.S. Patent No. 6,426,274 ("274 patent"). Indeed, that is only half the story, because the claims of the subject application are also substantially the same in scope as those of U.S. Patent No. 6,107,213 ("213 patent") and U.S. Patent No. 6,194,245 ("245 patent").

Further, it should be noted that the claims of the subject application are not unique to it, but rather, have been copied from the above patents for purposes of provoking an interference. Yet in the Office Action, a number of claims are objected to under 37 C.F.R. § 1.75 as being substantial duplicates of each other. This follows an Office Action dated September 17, 2003, in which an election of species requirement was imposed, and an Office Action dated January 16, 2004, in which a restriction requirement was imposed. This application was filed on March 1, 2002, over two years ago.

Taken together, these office actions manifest a desire to reduce the number of claims in this application. But what is being lost sight of is that the claims in this case are copied from issued patents, and that those issued patents contain a large number of claims. Further, the claims have been copied in this case to provide one vehicle for the orderly determination of priority to the inventions presently claimed elsewhere. The copying of claims identical, or nearly so, to those in existing patents for purposes of provoking an interference is a statutorily-sanctioned practice. See 35 U.S.C. § 135(b). This statute does not limit the applicant to copying only some claims, or those that are later determined to be reasonable in number. And for good reason; copying a patent's claims to the fullest extent possible (including in some instances, variations of the patent's claims) makes setting up the interference easier, reduces the opportunity to argue for the removal of claims from the interference based on minor distinctions, and allows a more complete determination of priority as to the subject matter that the patent owner claims as his own. Yet all of these laudable goals would be frustrated by limiting the number of copied claims. Thus the public gains nothing by adherence to the outstanding rejection, and in fact it is disserved.

As pointed out above, the number of claims in this application was dictated by the correspondingly large number of similar claims in the issued patents of the party with whom applicants seek to provoke an interference. Applicants' attorneys would be happy to assist the Office in any way possible so as to expedite a declaration of interference. However, for the reasons explained above applicants respectfully submit that the approach of reducing the number of claims in the subject application is ill-advised in the present situation.

IV. The September 17, 2003 and January 16, 2004 Office Actions

As stated above, this application was subject to an election of species requirement in the Office Action dated September 17, 2003. Applicants duly filed a response on October 17, 2003, in which the election of species requirement was traversed, and applicants explained that the election of species requirement was inconsistent with prior PTO treatment of this matter, as demonstrated by the issuance of the patents from which claims were copied. (See Response to Election of Species Requirement dated October 17, 2003, at pp. 2-3).

The subsequent Office Action dated January 16, 2004 did not address these points. Rather, it imposed a restriction requirement, in which applicants were required to elect for further prosecution either Group I claims 74-139 and 144-158, said to be drawn to processes, or Group II claims 140-143 and 159, said to be drawn to devices. As to the prior election of species requirement, the January 16, 2004 Office Action simply stated that in the event the Group I claims were elected, then the election of species requirement stated in the September 17, 2003 Office Action still applied.

Applicants filed another response on February 17, 2004, electing the claims of Group I, but with traverse. The applicants pointed out that, like the prior election of species requirement, the restriction requirement was inconsistent with issuance of the '280 and '274 patents, each of which contained both process and method claims. Applicants also reiterated the inappropriateness of the election of species requirement on the same basis as was already set forth in the October 17, 2003 response.

Despite the PTO receiving the February 17, 2004 substantive response, the subsequent Office Action (presently outstanding) does not address the points made by

applicants as to the restriction requirement or the prior election requirement, but rather simply states that applicants' election of the claims of Group I was acknowledged. MPEP § 707.07(f) indicates that if there is any traversal by an applicant, the grounds for the traversal must be taken note of and the substance answered. Applicants respectfully submit that the outstanding Action, to be complete, needs to address the points made in the prior responses by applicants, and specifically applicants are entitled to an explanation of why the restriction and election requirements should be maintained in the present situation.

In addition, as to the election requirement, claims 88, 90 and 133 are linking claims that have been allowed since they (as well as any claims from which they depend) are not subject to any rejection or objection (as noted above). Under these circumstances, it is improper to maintain any restriction requirement. As stated in MPEP § 809, "should any linking claim be allowed, the restriction requirement must be withdrawn." This is exactly the situation here.

Accordingly, applicants respectfully submit that the restriction and election requirements are inappropriate and should be withdrawn. In any event, applicants respectfully submit that since the arguments made in the prior Office Actions were not addressed, the present Office Action is premature and should be re-issued to address the deficiencies set forth above.

V. The June 8, 2004 Office Action

Turning to the merits, claims 78, 108, 134, 143, 158 and 159 have been objected to under 37 C.F.R. § 1.75, as being a substantial duplicate of claims 75. In the interests of expediting matters, applicants have cancelled herein claims 78 and 108. However, with regard to claims 134, 143, 158 and 159, it is submitted that the objection is

misplaced. In particular, claim 75 was copied from claim 1 of the '213 patent; whereas claim 134 herein is copied from claim 1 of the '280 patent; claim 143 herein is copied from claim 1 of the '274 patent; claim 158 herein is copied from claim 17 of the '274 patent; and claim 159 is copied from claim 18 of the '274 patent. Thus, it can be seen that all of the claims subject to objection are copied from different claims in issued patents. Indeed, it should be particularly noted that three of the claims (claims 143, 158 and 159), exist in the very same issued patent. Yet they were allowed to issue there without a similar objection being raised as to them. Under these circumstances, the proffered objection should be withdrawn.

Likewise, the objection under 37 C.F.R. § 1.75 to claims 109 and 144 as being substantial duplicates of claim 79 is traversed. First, claim 144 is copied from '274 patent claim 2, whereas claim 79 of the subject application reflects a different claim, '213 patent claim 2. There are therefore two claims, right now, contained in two separate United States patents, of essentially the same scope as claims 79 and 144 and which the Examiner concedes are to a common invention. The Examiner's objection, if met, would deprive applicants of the opportunity of seeking these claims in the subject application, and in so doing would potentially prejudice appropriate and correct disposition of the interference proceeding. As to claim 109, while it was also copied from '213 patent claim 2, its text is not the same as claim 79. This is done not to pointlessly increase the number of claims, but to assist in precluding the patentee from arguing that small differences render the patent claim at issue separately patentable from the interfering subject matter. Withdrawal of this objection as to claims 109 and 144 is therefore respectfully requested.

Applicants also traverse the objection under 37 C.F.R. § 1.75 to claims 128, 135, 136 and 157 as being substantial duplicates of claim 76. Claim 76 of the subject application was copied from '213 patent claim 20. In contrast, claims 135 and 136 were copied from '280 patent claim 1, and claim 157 was copied from '274 patent claim 16. Again, claims that the Examiner believes define a common invention are present in a plurality of issued patents. As to claim 128, while it was copied from '213 patent claim 20 (as was claim 76), the text of each of claims 76 and 128 differ from the other. Likewise, while claims 135 and 136 were both copied from '280 patent claim 1, their text plainly differs. As explained above, copying claims in different forms assists in resolution of the interference by making it more difficult to argue small differences as patentable distinctions. It is therefore respectfully requested that the objection to claims 128, 135, 136 and 137 be withdrawn.

Still further, applicants traverse the objection to claim 82 as purportedly failing to limit the subject matter of a previous claim. Claim 82 reflects claim 3 of the '213 patent, and its base claim, claim 80, reflects claim 2 of the '213 patent. Accordingly, as explained above with respect to other claims, the subject matter of claim 82 will remain in an issued U.S. patent, whether or not the objection is acceded to.

Claims 80, 84, 86, 96, 97 and 120 were also objected to for containing various informalities.

In response, applicants have amended claim 80 to remove the purported informality.

However, applicants traverse the objection to claims 84 and 86, in which it was asserted that there is no clear antecedent basis for the word "step" in these claims

because plural steps are previously recited. In fact, claims 84 and 86 depend from claim 81, which depends from independent claim 79, and that independent claim contains but one anodizing step, not plural steps. Hence there is proper antecedent basis for the referenced “step” in claims 84 and 86.

Applicants also traverse the objection to claim 96 (and apparently, claim 120 also) for its use of the term “rigid” (in referring to a “rigid substrate”), and to claim 97 for its use of the term “flexible” (in referring to a “flexible substrate”). These terms are common, every-day, well-understood terms. They are not unclear. Claims 96 and 120 were copied from ‘213 patent claim 14, and that claim uses the term “rigid.” Claim 97 was copied from ‘213 patent claim 15, and that claim uses the term “flexible.” These claims stand today in the issued ‘213 patent. Moreover, there are a number of other issued U.S. patents that refer to “rigid” and “flexible” substrates in their claims, as shown by the following:

- U.S. Patent No. 6,603,141 entitled “Organic Semiconductor and Method,” claim 2 of which recites “The device of claim 1 wherein the substrate comprises a flexible substrate”; and claim 3 of which recites, “The device of claim 1 wherein the substrate comprises a rigid substrate” (emphasis added).
- U.S. Patent No. 6,677,607 entitled “Organic Semiconductor Device Having an Oxide Layer,” claim 2 of which recites “The device of claim 1 wherein the substrate comprises a flexible substrate”; and claim 3 of which recites, “The device of claim 1 comprises a rigid substrate” (emphasis added).
- U.S. Patent No. 6,756,307 entitled “Apparatus for Electrically Planarizing Semiconductor Wafers,” in which claim 48, directed to a flexible planar cathode,

calls for “a flexible substrate” (emphasis added). See also claim 13 (“The method of claim 1, wherein the flexible planar cathode comprises a flexible substrate”); claim 37 (“The apparatus of claim 26, wherein the flexible planar cathode comprises a flexible substrate”); and, e.g., claims 62, 63, 64 (“flexible substrate”) (emphasis added).

- U.S. Patent No. 6,503,831 entitled “Method of Forming an Electronic Device,” claim 17 of which recites, “A method according to claim 1, wherein said surface comprises a flexible substrate” (emphasis added).

In view of the plain meaning of the terms “rigid” and “flexible,” and their use in the claims of a number of issued patents, applicants submit that claims 96, 97 and 120 are in proper form.

CONCLUSION

In conclusion, it is respectfully requested that the restriction/election requirements be withdrawn, as discussed at the October 6, 2004 interview and as further explained above, that the claim objections be withdrawn, and that the Examiner contact the undersigned to schedule a further interview to frame the interference.

Should the Examiner have any question at all, he is invited to call the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert H. Fischer", with a long horizontal line extending to the right.

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